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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,784	06/09/2006	Anthony Scott Oddo	SEDN/PRED115	2599
56015 7590 03/05/2009 WALL & TONG, LLP/ SEDNA PATENT SERVICES, LLC 595 SHREWSBURY AVENUE SUITE 100 SHREWSBURY, NJ 07702				
EXAMINER LEWIS, JONATHAN V				
ART UNIT 2425		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/552,784

**Applicant(s)**

ODDO ET AL.

**Examiner**

JONATHAN LEWIS

**Art Unit**

2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 21 is objected to because of the following informalities: "allowing the user to view the content of the selectedchannel" has no space between the words selected and channel. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-29 are rejected under 35 U.S.C. 101 as failing to fall within a statutory category of invention. The claimed invention is directed to non-statutory subject matter.

Claim 21 fails to fall within a statutory category of invention. It is not directed to a method within the meaning of 35 U.S.C. 101. It is clearly not a composition of matter, a machine, or an article of manufacture. Since the method can be executed by a person, without the use of a machine, it is not statutory. The steps of: "providing a content recommendation to the user upon detecting a channel change event" and "allowing the user to selectively view the recommended content" can be performed by a person without the aid or use of any hardware.

For example: in an environment where two users are viewing the same program, one user can recommend a program to view based on a channel change and he/she can share the remote to allow the other user to view the recommended content.

Claims 22-23 depend on claim 21, and are rejected for the same reasons as stated above.

Claim 24 fails to fall within a statutory category of invention. It is not directed to a method within the meaning of 35 U.S.C. 101. It is clearly not a composition of matter, a machine, or an article of manufacture. Since the method can be executed by a person, without the use of a machine, it is not statutory. The steps of: "monitoring content viewed by a plurality of users," "generating the user perceptible indicator" and "providing for interaction of the user with the user perceptible indicator" can be performed by a person without the aid or use of any hardware.

For example: in an environment where several users are viewing the same program, one user can monitor content the others are watching, write a perceptible indicator, and provide for interaction of the indicator by handing the other users the hand-written note.

Claims 25-29 depend on claim 24, and are rejected for the same reasons as stated above.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 21-23, 30, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art Alexander et al. (US Pat. No. 6,177,931) in view of Hane et al. (US PG Pub. No. 2002/0157096).**

Regarding claim 21, Alexander et al. teaches a method of displaying content recommendations to a user (Fig. 1, 14 shows the Ad window where content recommendations are displayed to the user), the method comprising: providing a content recommendation to the user upon detecting a channel change event, the channel change event associated with the user selecting a channel (col. 28, lines 30-52 discloses the monitoring of the channel change event, and col. 31, lines 25-33 disclose the provision of recommended content based on a channel change); and allowing the user to selectively view the recommended content or content of the selected channel (col. 18, lines 1-12).

Alexander et al. teaches all the claim limitations as stated above, except wherein the content recommendation is provided to the user prior to allowing the user to view the content of the selected channel.

However, Hane et al. teaches wherein the content recommendation is provided to the user prior to allowing the user to view the content of the selected channel (Fig. 13).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to provide a content recommendation prior to allowing the user to view the selected channel, in order to provide an accurate, flexible recommendation list to the user according to his/her preferences.

Regarding claim 22, Alexander et al. in view of Hane et al. teaches all the claim limitations as stated above, except the content recommendation is provided using one or more of a rating engine, recommendation engine and profile engine.

However, Alexander et al. teaches the content recommendation is provided using one or more of a rating engine, recommendation engine and profile engine (col. 30, lines 45-58).

Regarding claim 23, Alexander et al. in view of Hane et al. teaches all the claim limitations as stated above, except the providing the content recommendation comprises: generating at least one recommendation of local or remote content.

However, Alexander et al. teaches the providing the content recommendation comprises: generating at least one recommendation of local or remote content (col. 31, lines 34-47).

System claims 30, 37 are rejected for the same reasons as stated above in the corresponding method claims.

**Claims 24-29, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al. (US Pat. No. 5,983,214) in view of applicant's admitted prior art Alexander et al. (US Pat. No. 6,177,931).**

Regarding claim 24, Lang et al. teaches a method of providing to a user a user perceptible indicator of available content (Fig. 5), the method comprising: monitoring content viewed by a plurality of users, wherein the plurality of users is pre-selected by the user (col. 5, lines 45-65).

Lang et al. teaches all the claim limitations as stated above, except based on the content viewed by the plurality of users, generating the user perceptible indicator of at least a portion of the content viewed by the plurality of users. wherein the generating

occurs at a change in system state; and providing for interaction of the user with the user perceptible indicator.

However, Alexander et al. teaches based on the content viewed by the plurality of users, generating the user perceptible indicator of at least a portion of the content viewed by the plurality of users, wherein the generating occurs at a change in system state (col. 29, lines 31-55); and providing for interaction of the user with the user perceptible indicator (col. 31, lines 9-24).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to generate the indicator for content view by multiple user and provide interactivity, in order to provide a customizable way to display a program guide based on the user's profile information.

Regarding claim 25, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the monitoring comprises: detecting content viewed by a subset of the plurality of users.

However, Alexander et al. teaches the monitoring comprises: detecting content viewed by a subset of the plurality of users (col. 28, lines 22-29).

Regarding claim 26, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the change in system state comprises activation of a client device.

However, Alexander et al. teaches the change in system state comprises activation of a client device (col. 28, lines 24-26).

Regarding claim 27, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the change in system state comprises activation of a television viewing system or set top box associated with the user.

However, Alexander et al. teaches the change in system state comprises activation of a television viewing system or set top box associated with the user (col. 28, lines 30-32).

Regarding claim 28, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the change in system state comprises a channel change event.

However, Alexander et al. teaches the change in system state comprises a channel change event (col. 28, lines 33-44).

Regarding claim 29, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the interacting further comprises: responding to signals generated by a user-operated remote control device.

However, Alexander et al. teaches the interacting further comprises: responding to signals generated by a user-operated remote control device (col. 28, lines 25-26).

Regarding claim 35, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the change channel event is associated with the user selecting a new channel and wherein the user perceptible indicator is configured to allow the user to selectively view the recommended content or content of the new channel.



However, Alexander et al. teaches the change channel event is associated with the user selecting a new channel and wherein the user perceptible indicator is configured to allow the user to selectively view the recommended content or content of the new channel (col. 28, lines 30-52).

Regarding claim 36, Lang et al. in view of Alexander et al. teaches all the claim limitations as stated above, except the user perceptible indicator is provided to the user prior to allowing the user to view the content of the new channel.

However, Alexander et al. teaches the user perceptible indicator is provided to the user prior to allowing the user to view the content of the new channel (col. 28, lines 30-52).

System claims 31-34 are rejected for the same reasons as stated above in the corresponding method claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN LEWIS whose telephone number is (571)270-3233. The examiner can normally be reached on Mon - Fri 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian T. Pendleton/  
Supervisory Patent Examiner, Art Unit 2425